

II. Remarks

In paragraph 1 of the Office Action, the Examiner has noted a new art unit for the case, and in response this art unit is reflected in the instant filing.

In paragraph 2 of the Office Action, the Examiner has noted that the Response to the Board Appeal was procedurally premature, and has reopened prosecution.

In response, although the filing was premature, the Examiner is welcome to call at any time to expedite prosecution, especially when prosecution is being reopened.

In paragraph 3 of the Office Action, the Examiner has confirmed the restriction and election, which is correct.

In paragraph 4, the Examiner has graciously provided a copy of 35 U.S.C. Sec. 112, and in response, the consideration is acknowledged with appreciation.

In paragraph 5 of the Office Action, the Examiner has rejected claims 5, 8-15, and 17-31 pursuant to 35 U.S.C. Sec. 112. The Examiner contends that these claims are vague and indefinite.

In response, the rejection is respectfully traversed. The Board decision reflects no Sec. 112 issue with the claims, and the Board seems to have understood the claims perfectly well. See Decision at pages 3-4, where the Board correctly construed the claims. There was no remand to consider Sec. 112, and one would imagine that the Board would have raised this as an issue in the remand had there been any problem. As the Board did not see a Sec. 112 problem before and correctly construed the claims, and therefore Applicant believes the Board would do so again.

More so, the Sec. 112 rejections all reflect improper construction of the claims. The construction is improper because it is inconsistent with the construction given by the Board.

With regard to the contention that the claim limitation the shape of the package visually conveying information about an activity associated with the icon in which the article is

used is , as the Examiner contends “entirely subjective,” the contention is respectfully traversed.

The Examiner’s attention is drawn to the specification at page 2, lines 25-page 3, line 6. A generic shape or amorphous shape conveys no information about any activity associated with the icon in which the article is used. The Examiner contends that it is not clear what information about what activity in connection with the icon is conveyed. This contention is directed to breath, not indefiniteness of the claim. The claim is clear and not vague nor indefinite. Breath is not indefiniteness. See *In re Gardner*, 427 F. 2nd. 786 (C.C.P.A. 1970). See the Board’s Decision, page 3. This limitation was definitely understood by the Board. Therefore, this language is not vague and indefinite.

For other reasons, Applicant has returned to the language initially used in the claims of suggestive rather than the conveying information about. In both cases, the claims meet the requirements of Sec. 112. The PTO has applied the objective standard of what is suggestive to symbols in examining applications for trademark registration for decades. See, e.g., TMEP 1209.01(a) titled "Fanciful, Arbitrary, and Suggestive Marks." The PTO cannot contend that its objective standard is subjective.

As to the contention that the claim covers a backpack filled with hiking gear, the contention is traversed as premised on a misconstruction of the claim. The claim requires a replica, and the Examiner’s cited example of a backpack *per se* is not a replica. The claim is not indefinite nor vague, and the claim does not cover a backpack filled with hiking gear. Thus, the Examiner’s contended claim interpretation at the top of page 4 is incorrect as ignoring the claim requirement for a replica, as well as for being overly broad and inconsistent with the Board Decision.

With regard to the contention that there is a Sec. 112 disharmony between the preamble and the claim limitations, this too reflects a misinterpretation of the claims. The Examiner contends that the claim limitations of “object from a group...” and “locating” are vague

and indefinite because it is unclear what this has to do with the preamble, which the Examiner contends is “a method of making packaging/thematically shaped packaging.” This contention is respectfully traversed as ignoring the explicit preamble language of claim 1, making a combination. For consistency, this language has been adopted in other claims too. As evidenced by the Board’s Decision and correct claim interpretation, there is no disharmony in the claim limitations as regards the preamble, and no vagueness or indefiniteness when all requirements of the claim are considered.

With regard to the contention extending from the last paragraph of page 4 to the top of page 5 that packaging the packaging appears to be duplicative in claim 27, the contention is respectfully traversed. However, the rejection is moot in view of a substantial change to the claim subject matter.

In sum, the Board found no Sec. 112 problem with the claims the first time it properly construed the claims, and Applicant believes that the Board would make a second decision consistent with its first decision. There is no vagueness or indefiniteness in the claims when all limitations are considered.

In paragraph 6, the Examiner has graciously provided a copy of 35 U.S.C. Sec. 102, and in response, the consideration is acknowledged with appreciation.

In paragraph 7 of the Office Action, the Examiner has rejected claims 5, 9, 11, 13, 20-22, and 28-3 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are anticipated by Gossard.

In response the contention is respectfully traversed. The rejection is premised on a misconstruction of the claims, i.e., inconsistent with the construction in the Board Decision, as discussed above. First, the Examiner’s anticipation case does not include prior art evidence that the football of Gossard conveys information or suggests collecting memorabilia, as would be necessary to meet the prior art evidence standards of a Sec. 102 anticipation rejection. The

Examiner's hindsight interpretation of Gossard is not prior art evidence of anticipation. Using the language of the Board Decision at pages 4-5: "the examiner has not persuaded us that an artisan would associate educating pedestrians about safety awareness (collecting memorabilia) with Ajapoiu's (Gossard's) container...." Second, even assuming the Examiner had such evidence (which he does not), and that his claim interpretation is valid (which it is not because it is inconsistent with the Board Decision), the rejection evidence is still insufficient: If the activity were collecting sports memorabilia, the photograph would have no use in the activity of collecting—the photograph is that which is collected, but it is not used in the activity of collecting. Gossard is not sufficient prior art evidence that every claim requirement was in the prior art, and thus there is no anticipation based on Gossard.

Further, as per the amended claims, there is no evidence that the photograph is the kind of article that is removed from the package and thereafter used during the activity of collecting sports memorabilia. No cited art teaches or suggests a process for making the combination including a package shaped like a replica of an icon, the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. Because Gossard does not teach or suggest this claim requirement, the claim cannot be anticipated based on Gossard. Additionally, with no teaching or suggestion thereof, no combination of cited art can render the claims obvious, either.

A general problem with the anticipation and obviousness claim analysis in the rejection, as contrasted with the Board Decision, is that the Examiner seeks to establish anticipation of a method claim with an apparatus. The claims are directed to method steps, and this issue was addressed in the Brief. Gossard is not sufficient evidence of anticipation in part because it is a "shot in the dark" apparatus without discovery of the idea for the claimed process steps.

Additionally, it is noted that Gossard does not mention plastic, additional utility, a material or substance which can receive writing from a pen or magic marker, or constructing as a toy. This is all hindsight, not mentioned in Gossard, and not the evidence of anticipation that is required by Sec. 102.

Withholding a patent on grounds of statutory anticipation requires evidence that all claim requirements are taught by one reference. As per the Board Decision, "the examiner has not presented sufficient evidence from the prior art of the totality of the claim was suggested to an ordinary artisan." Thus, on appeal again, the rejection will be reversed again, at least because there is no teaching of the claimed shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package.

In paragraph 8, the Examiner has graciously provided a copy of 35 U.S.C. Sec. 103(a), and in response, the consideration is acknowledged with appreciation.

In paragraph 5 of the Office Action, the Examiner has rejected claims 8, 10, 12, 14, and 15 pursuant to 35 USC Sec. 103(a). The Examiner contends that these claims are obvious over Gossard.

In response, the rejection is respectfully traversed. Incorporate by reference the above discussion of Gossard in connection with the Sec. 102 rejection. The errors begin to compound from the above-discussed incorrect claim construction and undisclosed claim requirements.

More particularly, the Examiner contends that although there is no disclosure of the claimed shapes, substitution would be a matter of design choice "since applicant has failed to disclose that the limitation solves any stated problem" (Office Action at page 7).

The contention is respectfully traversed. The Examiner is drawn to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10,

etc., wherein there is a discussion of how “the limitation solves any stated problem.” The problem has not been shown to have been recognized in the prior art, so the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant’s claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole.

The Examiner is reminded that the reasoning that a change in design shape is a matter of design choice was rejected once by the Board, and Applicant believes that the Board would be consistent with itself. The present case is distinguishable from Dailey in that the design choice of the present invention has a claimed cooperation in the combination, and this claimed cooperation is not found in Dailey.

With regard to the Examiner’s contention that it was “within the scope of Gossard to have the container be shaped to represent any sport associated with the photograph,” this again reflects a misconstruction of the claims. As stated above, Gossard does not teach or suggest an activity associated with the icon in which the article is used. If the activity were collecting sports memorabilia, the photograph would have no use in the activity of collecting—the photograph is that which is collected, but it is not used in the activity of collecting. More so, under the amended claims, Gossard also fails to teach or suggest an activity associated with the icon in which the article is used during the activity, after removal from the package.

Turning to the requirements of Sec. 103(a), nothing teaches or suggests a process for making the combination including a package shaped like a replica of an icon wherein the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. Therefore, a prima facie case of obviousness has not been evidenced.

The Examiner has rejected claim 17 pursuant to 35 U.S.C. Sec. 103(a). The

Examiner contends that this claim is obvious over Gossard in view of Francis.

In response, the rejection and contention are respectfully traversed. Incorporate the foregoing sections pertaining to Sec. 102 and 103, wherein it is respectfully mentioned that the rejection is premised on an improper construction of the claims and also fails to teach or suggest a process for making the combination including a package shaped like a replica of an icon wherein the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. It is not true that "Gossard teaches all of the claimed invention except for locating the logo..." as is contended in the Office Action on page 7.

Further, the errors compound with regard to Francis, as the Examiner contends that "Francis discloses that it was notoriously well known in the art of packages to place a logo thereon..." The contention is respectfully traversed: Francis does not show a logo.

In addition, building on the errors compounding from the absent teaching of a claim requirement discussed in Sec. 102 and Sec. 103 above, the Examiner's contention reflects an attempt to expand an isolated element into the process invention as a whole. Although Francis does not teach the logo, the Examiner contends that "it would have been obvious... to locate a logo on the Gossard package, as taught by Francis, in order to represent what the package contains." This argument presumes Applicant's invention—Francis also does not teach or suggest the use of a logo "in order to represent what the package contains," i.e., football cards. In any case, the combination does not teach or suggest the claim requirement discussed above in connection with the Sec. 102 and Sec. 103 rejection, and thus a *prima facia* case of obviousness has not been evidenced.

The Examiner has rejected claims 18 and 27 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious over Gossard.

In response, the contention is respectfully traversed. Incorporate the foregoing

sections pertaining to Sec. 102 and 103, wherein it is respectfully mentioned that the rejection is premised on an improper construction of the claims and also fails to teach or suggest a process for making the combination including a package shaped like a replica of an icon wherein the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. This it is not true that "Gossard teaches all of the claimed invention except for..." as is contended in the Office Action on page 7.

Further, at page 8 of the Office Action, the Examiner contends that a claim feature is inherently old and well known as follows:

Gossard...does not specifically disclose adding an outer layer of packaging also shaped to visually convey information about the associated activity. It would have been an obvious matter of design choice to add an outer layer of packaging also shaped to visually convey information about the associated activity since this is an inherently old and well known concept...

A reference is required for what the Examiner contends as old and inherently well known, at least so a proper determination can be made as to whether there is a valid reason to combine/modify.

Additionally, the Examiner's rejection does not reflect a proper construction of the claims. The Examiner states at page 8 of the Office Action:

in the art of packaging/marketing (i.e., adding a plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents, and also printing the contents or various characteristics of the contents on the outside layer of packaging, which in the instant case may conclude: "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer).

However, claim 18 requires that the outer shape of the packaging be shaped to visually suggest the associated activity, and the claimed shape is not disclosed by a plastic bubble packaging to protect an item during shipping, nor is the claimed shape shown by printing, as the Examiner contends.

The rejection of claim 27 is moot in view of the amendment to different subject matter. In any case, a *prima facie* case of obviousness has not been made out as discussed above.

The Examiner has rejected claim 23 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that this claim is obvious over Gossard in view of Shaffer.

In response, the rejection is respectfully traversed. Incorporate the foregoing sections pertaining to Sec. 102 and 103, wherein it is respectfully mentioned that the rejection is premised on an improper construction of the claims and also fails to teach or suggest a process for making the combination including a package shaped like a replica of an icon wherein the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. Thus, the evidence is insufficient to show statutory obviousness. Furhter, a proper reason to combine/modify has not been shown. The Examiner contends that “it would have been obvious... to provide a means for attaching the replica for attaching the replica to another article on the Gossard method as taught by Schaffer in order to provide a convenient carrying mechanism.” A good question is why one would have thought to have such a mechanism on Gossard, a novelty container for photographs that would presumably open constantly from use of the Schaffer means for attachment, thereby defeating Gossard’s purposes of containing and protecting the photographs. In the words of the Board Decision at pages 4-5: “the examiner has not persuaded us that an artisan would associate....”

In sum, no cited art teaches or suggests a process for making the combination including a package shaped like a replica of an icon, the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package. Because Gossard does not teach or suggest this claim requirement, the claim cannot be anticipated based on Gossard. Additionally, with no teaching

or suggestion thereof, no combination of cited art can render the claims obvious. As to Sec. 112, there was no remand to consider Sec. 112, and one would imagine that the Board would have raised this as an issue in the remand had there been any problem. As the Board did not see a Sec. 112 problem before and correctly construed the claims, and Applicant believes the Board would do so again. This result is even more likely in view of the amendment because it incorporates the PTO's objective standard shown in TMEP 1209.01(a) titled "Fanciful, Arbitrary, and Suggestive Marks." It is not likely that the PTO would go to the Federal Circuit to argue that its own standard was vague, indefinite, and subjective.

In paragraphs 13 and 14, the Examiner has found claims 19 and 24-26 to be allowable if rewritten to overcome the Sec. 112 rejection. Applicant appreciates the finding that the claims would be allowable, and the claims are believed to be compliant with Sec. 112, as discussed above, and the discussion incorporated here by reference.

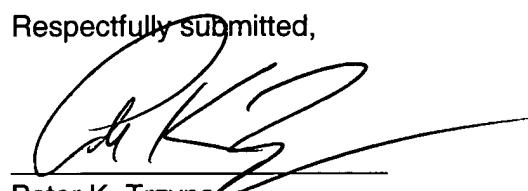
In paragraph 15 of the Office Action, the Examiner has made of record that which is contended to be "prior art" not relied upon.

In response, Applicant traverses and objects to the mention of Des 390,778 as "prior art" because it was filed after both the Applicant's filing date and Applicant's priority date. Des 390,778 is not prior art.

III. CONCLUSION

The application, as amended, is believed to be in condition for allowance, and favorable action is requested. Again, in view of the Decision reversing the rejection and the delay in issuance of this application in view of the appeal, if the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

Respectfully submitted,



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